

Atty. Docket No. 412589

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REMARKS/ARGUMENTS

Claims 1-3, 5, 9, 8, 21, 22 and 25-32 remain pending in this application (hereinafter, the "373 Application"). Claims 1 and 25 are amended to incorporate a limitation found in claim 4. Accordingly, claim 4 is cancelled. Claim 7 is also cancelled herewith. All of the aforementioned claims stand rejected.

It is believed that the following remarks attend to all issues presented in the Office Action dated 18 April 2006. Headings presented below reflect the order of issues presented in the aforementioned Office Action.

2. Election/Restrictions

We thank the Examiner for acknowledging Applicant's prior election of Group I, species I.

3-4. Claim Rejections – 35 U.S.C. § 102

The Detailed Action found on page 2 of the pending Office Action states that "Claims (FILL IN) are rejected under 35 U.S.C. 102(b) by Hornsby (U.S. Patent No. 4,032,687)." Office Action p. 2, item 4. Per the Office Action Summary page, we believe that all of claims 1-8, 21, 22 and 26-32 are rejected in view of the aforementioned patent (hereinafter, "Hornsby"). We therefore argue each of claims 1-8, 21, 22 and 25-32 herein below. We respectfully request clarification if we have incorrectly interpreted the Examiner's rejection.

We respectfully disagree with the rejection of claims 1-8, 21, 22 and 25-32. In order to anticipate the aforementioned claims, Hornsby must teach every element of the claim and "the identical invention must be shown in as complete detail as contained in the ... claim." MPEP 2131 citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). As explained in the following claim-by-claim discussion, Hornsby does not fulfill this requirement, therefore, no anticipation can be found.

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Independent Claim 1: Amended claim 1 is directed to a symbol-bearing receptacle for a fluid, including:

- (a) a container for said fluid; and
- (b) a transparent symbol disposed on said container, said symbol having a water reactivity that differs from water reactivity of said container.

In asserting that claim 1 is anticipated by Hornsby, the Examiner states: "The symbol is deemed to have a water reactivity that differs from the water reactivity of the container." Office Action p. 2, final two lines.

Respectfully, we must disagree. Hornsby does not mention water reactivity, anywhere. Per MPEP §2131, "A claim is anticipated only if each and every element as set forth in the claim is found, *either expressly or inherently described*, in a single prior art reference." MPEP §2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added. Since Hornsby does not expressly describe (or even suggest) differing water reactivity, we believe the Examiner is essentially making an argument that a symbol and a container having differing water reactivity are inherently described in Hornsby. However, regarding inherency, MPEP § 2112 states:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2D 1461, 1464 (Bd. Pat. App. & Int. 1990)."

The Examiner provides no basis in fact to support inherently present and differing water reactivities of Hornsby's appliqué and cup. In keeping with the above requirements, the Examiner does attempt to provide technical reasoning, particularly stating that "The symbol and the container can either be hydrophilic or hydrophobic, since the reference discloses that the symbol and the container can either be paper or plastic". Office Action p. 3, lines 1-2. However, this reasoning is insufficient because

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the Examiner does not show that differing water reactivities are necessarily present. Furthermore, the above statement is not entirely correct. Hornsby does not teach a symbol that is paper or plastic, but rather recites an appliqu  that is made up of both paper and plastic components. There is no mention of water reactivity (e.g., hydrophilic or hydrophobic) of the complete appliqu .

For example, Hornsby's appliqu  is described as having a base layer 14 that "can be formed of paper or plastic" col. 3, line 8. However, base layer 14 is backed with an attaching medium 20, which "would ordinarily comprise a highly tackified synthetic polymer with permanent sticky properties...Typical pressure sensitive adhesive materials are those including a rubbery polymeric compound, with suitable compatible resinous tackifiers and dispersed in an appropriate solvent." Hornsby col. 2, lines 55-64. The base layer 14 is covered on its opposite side by indicia means 34, a liquid crystal material 26 and a transparent protective layer 28, "in such a manner as to fully envelop and protect the liquid crystalline layer 26," Col. 3, lines 51-53; see also FIG. 3. Again, Hornsby is silent as to hydrophobic, hydrophilic or otherwise water reactive properties of this complete appliqu .

Specific water reactivities of Hornsby's appliqu  and cup are not taught, depicted or even mentioned. Furthermore, the Examiner has not shown that differing water reactivities are necessarily present in Hornsby. Once more, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. *The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*" MPEP §2112(IV), quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The rejection under 35 U.S.C. §102 therefore fails.

Although we believe that claim 1 is allowable "as is", the claim is further amended to recite a transparent symbol. Hornsby does not teach or suggest a transparent symbol, instead reciting an visible appliqu  with several visible and colorful layers.

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Hornsby's appliqu  includes indicia means 34, which "can take the form of a printed advertising message, an insignia or other forms of printed or artistic matter" col. 4, lines 1-3; see also FIGs. 4-5. Hornsby nowhere indicates that the indicia means, a part of the appliqu , is transparent. Indeed, transparent indicia means would counter Hornsby's aforementioned advertising objectives. The indicia means is meant to be seen, and is therefore not transparent. In addition, a layer of liquid crystalline material overlies the indicia means. As is known in the art, liquid crystalline material is not transparent when within its event temperature range, instead appearing colorfully opaque and metallic. Hornsby thus fails to teach, or even suggest, a transparent symbol, as in Applicant's claim 1. Claim 1 is not anticipated, thus, we respectfully request withdrawal of the Examiner's rejection.

Claims 2 & 3: Claims 2 and 3 depend from claim 1, and benefit from like argument. Furthermore, claims 2 and 3 respectively require a hydrophobic symbol with a hydrophilic container, and a hydrophilic symbol with a hydrophobic container. As the Examiner notes, Hornsby recites a paper or plastic cup. However, Hornsby gives no indication of any overall hydrophilic or hydrophobic property of his appliqu . Therefore, Hornsby fails to teach the limitations of claims 2 and 3, and there is insufficient evidence to prove that these limitations are "*necessarily* present in the thing described in the reference," MPEP §2112(IV), quoting *In re Robertson*, presented in full, above. Withdrawal of the Examiner's rejection is therefore respectfully requested.

Claim 5: Claim 5 depends from claim 1, and benefits from like argument. Withdrawal of the Examiner's rejection is therefore respectfully requested.

Claim 6: We must also respectfully disagree with the rejection of claim 6. Claim 6 recites a symbol comprising a silicone film. Claim 6 depends from claim 1, which describes the symbol as being "disposed on said container". Hornsby does not teach a symbol disposed on a container and comprising a silicone film. The only mention of silicone in Hornsby comes in describing the release layer provided on a backing paper that is stuck to the bottom of Hornsby's appliqu , for protection prior to application. The

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release paper and the silicone are peeled off of Hornsby's appliqu , *so that the appliqu  can be stuck to a desired surface*. Therefore, Hornsby's appliqu  does not include the silicone when disposed on a cup. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 7: Claim 7 depends from claim 1, and benefits from like argument. We respectfully request withdrawal of the Examiner's rejection.

Claim 8: Claim 8 is not also not anticipated. Hornsby does not teach a symbol embedded in the surface of a container. Rather, Hornsby's symbol is affixed to a surface and peeled off for re-use. See col. 4, lines 41-52. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 21: Claim 21 depends from claim 1, and recites that the container comprises a confined passageway disposed within a surface thereof. There is simply no teaching, depiction or hint of such a confined passageway in Hornsby. Therefore, anticipation is not established, and we respectfully request withdrawal of the Examiner's rejection.

Claim 22: Claim 22 depends from claim 21, and further recites that the confined passageway is configured for holding a coolant. Hornsby is not only silent as to any such confined passageway, Hornsby also fails to mention a coolant, anywhere. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 25: Claim 25 is directed to a symbol-bearing receptacle for a fluid, including:

- (a) a container for the fluid, the container comprising an open fluid receptacle formed of a base disposed upon a substrate and a wall affixed to and extending upwardly from the base; and
- (b) a transparent symbol disposed on the base and facing said substrate, the symbol having a water reactivity that differs from a water reactivity of the container.

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As argued with respect to claim 1, Hornsby is silent as to water reactivities, and the Examiner's line of technical reason does not show that differing water reactivities are necessarily present in Hornsby. Furthermore, Hornsby does not teach a transparent symbol, instead specifying an appliqué with indicia means that are "imprinted upon the upper surface 16 of the base sheet 14, or alternatively can be imprinted upon the overlying transparent layer 28." Hornsby col. 3, lines 65-68; see also FIGs. 3-5. Hornsby fails to teach at least two limitations of claim 25, thus, rejection under 35 U.S.C. § 102(b) fails. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 26: Claim 26 depends from claim 25, and benefits from like argument. Claim 26 also recites the unique limitation of a symbol comprising a pattern that develops on a surface supporting the base, due to water condensation. Hornsby simply teaches nothing of the sort. Claim 26 is not anticipated. Accordingly, we request withdrawal of the Examiner's rejection.

Claim 27: Claim 27 also depends from claim 25, and further recites a base comprising a material surrounding the symbol that is dissimilar to material forming the symbol. Respectfully, Hornsby does not specify a base material at all, let alone a base material that is dissimilar to material of a symbol disposed thereon. Withdrawal of the Examiner's rejection is respectfully requested.

Claims 28 & 29: Claims 28 and 29 depend from claim 27, and further recite hydrophobic base material surrounding a symbol formed of hydrophilic material (claim 28) and vice-versa (claim 29). As noted above with respect to claims 2 & 3, Hornsby gives no indication of any overall hydrophilic or hydrophobic property of his appliqué. Therefore, there is insufficient evidence to prove that the hydrophobic/hydrophilic relationships of claims 28 and 29 are "necessarily present in the thing described in the reference," MPEP §2112(IV), quoting *In re Robertson*, presented in full, above. Withdrawal of the Examiner's rejection is therefore respectfully requested.

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Claim 30: We must also respectfully disagree with the Examiner's rejection of claim 30. Hornsby absolutely does not teach or suggest a plurality of base extensions elevating a substrate from said base, wherein one or more of the base extensions form a symbol. Withdrawal of the Examiner's rejection is requested.

Claims 31 & 32: These claims recite limitations also found in claims 21 and 22, argued above. As noted with respect to these claims, Hornsby does not teach a container with a confined passageway disposed within a surface thereof, let alone such a passageway configured for holding a coolant. See arguments in support of claims 21 and 22. We respectfully request withdrawal of the Examiner's rejection.

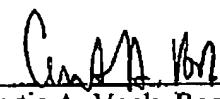
CONCLUSION

We have shown that Hornsby does not teach, or even suggest the limitations of the pending claims. We have also shown that there is insufficient evidence or technical reason to support inherent presence of Applicant's claimed subject matter in Hornsby. We thus respectfully request allowance of all of claims 1-3, 5, 6, 8, 21, 22 and 25-32.

No fees are believed due. However, should any fee be deemed necessary in connection with this Amendment and Response, please charge Deposit Account No. 12-0600. Should any issues remain outstanding, the Examiner is encouraged to telephone the undersigned attorney.

Respectfully submitted,
LATHROP & GAGE L.C.

By


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